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EXAMINER

WARE, CICELY Q

ART UNIT PAPER NUMBER

2634

DATE MAILED: 08/02/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/780,470

Applicant(s)

EDLIS ET AL.

Examiner

Cicely Ware

Art Unit

2634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 12-19 is/are rejected.
- 7) ☒ Claim(s) 10 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, 8, 9, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kornfeld et al. (US Patent 5,758,266) in view of Hottinen (US Patent 5,936,950).

(1) With regard to claim 1, Kornfeld et al. discloses interrupting reception from a first communication system; searching for a pilot signal of a second communication system while being in communication with a first communications system and resuming reception from said first communications system (abstract, col. 1, lines 50-63, col. 2, lines 36-51, col. 3, lines 13-18).

However Kornfeld et al. does not disclose a second communications system that operates according to a different communication standard than said first communication system.

However Hottinen discloses a second communications system that operates according to a different communication standard than said first communication system (col. 3, lines 12-15, 29-32).

Therefore it would have been obvious to one of ordinary skill in the art to modify Kornfeld et al. to incorporate a second communications system operates according to a different communication standard than a first communication system in order to provide for different multiple access methods to be transmitted in overlapping frequency bands (Kornfeld et al., col. 2, lines 1-5).

(2) With regard to claim 2, claim 2 inherits all the limitations of claim 1. Kornfeld et al. further discloses searching comprising recording online a portion of signals received from said second communications system; and background processing said portion of signals to search for said pilot signal (col. 2, lines 17-51).

(3) With regard to claim 3, claim 3 inherits all the limitations of claim 2. Kornfeld et al. further discloses wherein a portion of signals is a portion spread spectrum signals (col. 1, lines 38-53).

(4) With regard to claim 4, claim 4 inherits all the limitations of claim 3. Kornfeld et al. further discloses wherein said processing comprises performing Code Division Multiple Access (CDMA) acquisition (col. 1, lines 50-60).

(5) With regard to claim 5, claim 5 inherits all the limitations of claim 2. Kornfeld et al. further discloses wherein said portion of signals is a portion of CDMA signals, and said first and second communications systems are transmitting on different frequencies (abstract, col. 1, lines 63-65, col. 3, 16-27).

(6) With regard to claim 8, claim 8 inherits all the limitations of claim 4. Kornfeld et al. further discloses wherein said performing of CDMA acquisition comprises finding a correlation between a pseudo-noise sequence of said portion of spread spectrum

signals and one of a plurality of known PN sequences (col. 1, lines 50-60, col. 2, lines 17-51).

(7) With regard to claim 9, claim 9 inherits all the limitations of claim 8. Kornfeld et al. further discloses shifting the PN sequence of said portion of spread spectrum signals (col. 1, lines 40-42, 46-48, 50-60).

(8) With regard to claim 12, claim 12 inherits all the limitations of claim 1. Kornfeld et al. further discloses a dual mode receiver comprising: a searcher adapted to search a pilot signal of a second communications system, while being in communication with a first communications system (abstract, col. 1, lines 50-63, col. 2, lines 36-51).

(9) With regard to claim 13, claim 13 inherits all the limitations of claim 12. Kornfeld et al. further discloses a memory adapted record online a portion of signals received from said second communications system; and a background processing unit adapted to process a portion of signals to offline to search for said pilot signal (col. 2, lines 17-51).

3. Claims 6, 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kornfeld et al. (US Patent 5,758,266) in combination with Hottinen (US Patent 5,936,950) as applied to claims 1, 2, 5 and 13 above, in view of Vilmur (US Patent 5,950,131).

(1) With regard to claim 6, claim 6 inherits all the limitations of claim 5. However Kornfeld et al. in combination with Hottinen does not disclose wherein recording

comprises recording said portion of CDMA signals after converting the portion of CDMA signals from an analog signal to a digital signal.

However Vilmur discloses a radiotelephone in a CDMA communication system wherein recording comprises recording a portion of CDMA signals after converting the portion of CDMA signals from an analog signal to a digital signal (Fig. 1 (112, 128), col. 5, lines 2-5, 29-52).

Therefore it would have been obvious to one of ordinary skill in the art to modify Kornfeld et al. in combination with Hottinen to incorporate wherein recording comprises recording a portion of CDMA signals after converting the portion of CDMA signals from an analog signal to a digital signal for fast and accurate pilot searching (Vilmur col. 3, lines 31-32).

(2) With regard to claim 14, claim 14 inherits all the limitations of claim 13 above. Vilmur further discloses wherein said portion of signals comprises a portion of spread spectrum signals (col. 5, lines 39-43).

(3) With regard to claim 15, claim 15 inherits all the limitations of claim 13 above. Vilmur further discloses wherein said portion of signals comprises a portion of CDMA signals (col. 2, lines 21-22).

(4) With regard to claim 16, claim 16 inherits all the limitations of claim 15. Kornfeld et al. further discloses wherein said portion of CDMA signals comprises a PN sequence (col. 1, lines 50-51).

(5) With regard to claim 17, claim 17 inherits all the limitations of claim 16. Kornfeld et al. further discloses wherein said background processing unit is to perform

CDMA acquisition by processing said portion of CDMA signals offline (col. 2, lines 17-51).

(6) With regard to claim 18, claim 18 inherits all the limitations of claim 17. Kornfeld et al. further discloses wherein said background processing unit is to find a correlation between the PN sequence and one of a plurality of known PN sequences (col. 1, lines 50-60, col. 2, lines 17-51).

(7) With regard to claim 19, claim 19 inherits all the limitations of claim 15. Kornfeld et al. further discloses wherein said first and second communications systems comprise at least one of CDMA, Advanced Mobile Phone Service (AMPS), Frequency Division Multiple Access (FDMA), Time Division Multiple Access (TDMA), and Global System for Mobile communication (GSM) communication systems (col. 1, lines 31-37, col. 2, lines 36-39).

4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kornfeld et al. (US Patent 5,758,266) in combination with Hottinen (US Patent 5,936,950) as applied to claim 5 above, in view of Rotstein et al. (US Patent 6,289,228).

With regard to claim 7, claim 7 inherits all the limitations of claim 5. However Kornfeld et al. does not disclose wherein said recording comprises recording said portion of CDMA signals after digitally processing the portion of CDMA signals.

However Rotstein et al. discloses a DS-CDMA communication system wherein recording comprises recording a portion of CDMA signals after digitally processing the portion of CDMA signals (Fig. 2 (110, 114, 116, 128), col. 7, lines 5-13).

Therefore it would have been obvious to one of ordinary skill in the art to modify Kornfeld et al. to incorporate wherein recording comprises recording a portion of CDMA signals after digitally processing the portion of CDMA signals so that it is unnecessary to monitor all the paging channels to detect paging activity (Rotstein et al. col. 7, lines 10-13).

### ***Allowable Subject Matter***

5. Claim 10 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cicely Ware whose telephone number is 703-305-8326. The examiner can normally be reached on Monday – Friday, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Chin can be reached on 703-305-4714. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.




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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

*Cicely Ware*

cqw  
July 7, 2004



STEPHEN CHIN  
SUPERVISORY PATENT EXAMINER  
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